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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,718	11/12/1999	JEFFERY M. ENRIGHT	D-1113	2011

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
3622	5

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PA

Office Action Summary	Application No.	Applicant(s)	
	09/439,718	ENRIGHT, JEFFERY M.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 March 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-43 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 November 1999 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7 March 2002 (Paper No. 4) have been fully considered but they are not persuasive. A detailed explanation is given with the following final rejection.

Claim Rejections - 35 USC § 103 and 35 USC § 102

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. Phillips et al. teaches (independent claim 38): a) accepting an amount of cash for the merchandise (col. 27 lines 22-39); b) generating a code for the amount of change (col. 3 lines 13-22); c) outputting the code on a receipt and d) paying a second charge by inputting the code (col. 3 lines 41-42). The receipt reads on indicia representative of the code (claim 39).

6. Claims 1-37 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. in view of Gatto.
7. Phillips et al. teaches (independent method claims 1 and 40, and apparatus dependent claim 27) a method and apparatus, the method comprising: a) paying a charge for motor fuel first goods (merchandise) delivered to a user at a self-service dispensing machine, including reading a credit card (col. 1 line 12 and col. 3 lines 38-39); b) receiving an input from the user through an input device adjacent the dispensing machine, wherein the input corresponds to a request for a second good, and c) charging the credit card for the charge and the second good (col. 3 lines 39-40); d) outputting a receipt usable for dispensing the second good from the seconds good dispensing apparatus (col. 3 lines 41-42), which reads on communicating information representative of the request for the second good to a facility including a supply for the second good, and e) delivering the second good from the supply after the user arrives at the facility.
8. Phillips et al. does not teach that the facility is remote from the machine. However, Phillips et al. does teach (col. 2 lines 42-54) that is desirable to attract customers into a mini-market at the vehicle fueling facility, which reads on a facility remote from the machine. Because of this suggestion to improve sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to place the second goods in the mini-market facility remote from the machine.
9. Applicant argues (p. 8) that Phillips et al. does not teach or suggest locating the vending machine inside of the mini-market. That is correct, but irrelevant. Phillips et al. has been cited for its identification of a problem and its suggestion of a solution, but not for the solution that it provides. Phillips does teach (at col. 2 lines 42-54, which was erroneously labeled col. 3 in the first Office action, but correctly marked in the reference copy provided to applicant) that is desirable to attract customers into the mini-market. The reference notes in particular (col. 2 lines 50-54) that the use of credit cards has exacerbated the problem of getting the consumer into the mini-market so as to increase sales to the consumer.
10. As a solution, Phillips et al. teaches a vending machine located on the fuel pump island. That can be expected to increase sales, but it is hardly a perfect solution to the problem identified by Phillips et al. That solution has the obvious disadvantage of limiting sales to some small fraction of the goods available in the mini-market. Examiner is arguing that, for

this reason, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use the mini-market itself as the venue for retailing the second goods.

11. Applicant has given reasons (beginning at the last para. on p 8) why the solution of Phillips et al. would be preferred over encouraging the customer to enter the mini-market to purchase second goods. Some of these reasons do have merit, e.g., customers with small children probably would prefer the convenience of second goods available at the island, assuming of course that the second goods offered are what the customer wants. But the advantage of being able to present to the customer the entire selection of goods available in the mini-market is great enough to make it an obvious preference over the Phillips et al. solution, locating a vending machine on the fuel pump island.
12. Applicant argues (beginning at the second para. of p. 9) that Gatto et al. is limited to transactions adjacent the fuel pump; not concerned with a facility remote from the fuel pump; and not concerned with delivering a requested amount of cash. As noted in the following rejection paragraph, the reference teaches "pay inside" and "cash back", which reads on transactions remote from the fuel pump and concerned with delivering a requested amount of cash.
13. Phillips et al. does not teach that the second good is an amount of cash. Gatto teaches a second good that is an amount of cash (col. 1 line 30 and col. 6 lines 25-26). Because dispensing cash could be expected to increase store traffic and therefore sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to dispense cash-back in the mini-market facility remote from the machine.
14. Phillips et al. does not teach (claim 40) a cash dispensing device remote from the customer request station. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference does teach "pay inside" and "cash back", which at very least requires a cash register in the mini-market, and that reads on a cash dispensing device remote from the customer request station.
15. At the reference points given above, Phillips et al. does teach claims 2, 3, 12, 13, 20, 22-24 and 41.

16. Applicant argues (middle of p. 11) that Phillips et al. does not teach claim 3. The reference teaches a mini-market (col. 2 line 47), which reads on the claim.
17. Phillips et al. also teaches: (claims 4-6, 18, 19, 28-32 and 37) that the receipt is printed with a bar code (col. 9 lines 38-58) and (claims 7 and 8) the receipt reader (col. 9 line 28-37) is operatively connected to the second goods dispenser, which inherently would have to be loaded from a larger supply; (claims 9 and 21) displays for prompting a customer (col. 5 lines 53-60); and (claims 10 and 11) conventional credit-card accounting mechanisms (col. 2 lines 2-10).
18. Phillips et al. does not teach (claims 14-17 and 33-35) a debit or stored value cards, and receiving a further input corresponding to the user. Gatto teaches debit and stored value cards (col. 3 lines 26 and 44-45). Because these cards facilitate sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add this teaching of Gatto to those of Phillips et al. Gatto also teaches receiving a further input corresponding to the user (col. 4 lines 8-12 and 34-37). Because this further input is solicited to either enhance security or elucidate user preference, either of which can be expected to enhance the business, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to also add this teaching of Gatto to those of Phillips et al.
19. Neither of the references teach (claims 25, 26 and 36) that the facility includes a service window and that the further input corresponds to a feature of the user's vehicle. Official notice is taken (MPEP § 2144.03) that these limitations were common, at the time of the instant invention. A drive-up service window would be especially attractive as a customer convenience feature at a facility dispensing motor fuel and small items such as cash. "Speed passes" and similar vehicular identifiers also provide the customer with obvious convenience, and therefore support the business.
20. Neither of the references teach (claims 42 and 43) a self-service automated cash dispensing device (ATM) remote from the customer request station. However, Gatto does teach a plurality of self-service automated cash dispensing devices 10 also comprising the customer request station (col. 6 lines 20-26), implicitly to be located at or near the fuel pump (col. 4 lines 59-63), and which function as an ATM (col. 6 line 5). Because it would provide security commonly provided for ATMs and for mini-markets, it would have been obvious to one of

ordinary skill in the art, at the time of the invention, to place one of the devices 10 inside the mini-market, which reads on remote from the customer request station.

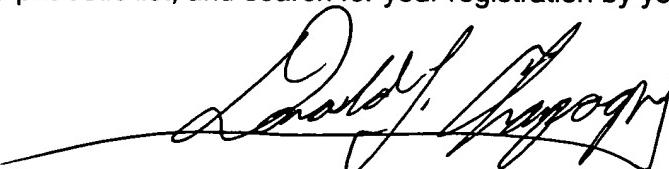
Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and informal fax communications may be sent directly to the examiner at 703-746-5536.
24. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.
25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov.

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6 May 2002

Donald L. Champagne
Examiner
Art Unit 2162